

REMARKS

Claims 1-6 are pending in this application. Claims 2-6 stand allowed.

The drawings were objected to as failing to show the “first light guide member and second light guide being in one body and the joint portion for connecting the first and second light guide members together”. This objection is respectfully traversed, as these features are depicted in Fig. 7 and are described on page 20, paragraph 2. Reconsideration and withdrawal of this object is requested.

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential structural cooperative relationships of elements, amounting to a gap between the necessary structural connections and a failure to particularly point out and distinctly claim the invention. Specifically, the Examiner alleged that it is not clear how the utility effect or operation is undertaken between the irradiation portion adapted to apply the light, the reflecting portion, the interior of the hollow portion, and the light guide member. This rejection is traversed.

Under 35 U.S.C. § 112, second paragraph, the case law relates the inquiry of whether or not the claims particularly point out and distinctly claim the invention to definiteness of claim language to ensure the public notice function of the claims and to provide a clear measure that the applicants set forth what they regard as their invention. The case law requires definiteness of claim language to be analyzed in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made (see, e.g., MPEP § 2173.02). So long as one of ordinary skill in the art could understand how to avoid infringement, the public notice function is satisfied.

See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379 (Fed. Cir. 2000). It is submitted that one of ordinary skill in the art, in view of the application disclosure, including the disclosed relation between the irradiation portion (e.g., 27, 32), the reflecting portion (e.g., 30), the interior of the hollow portion (e.g., 29), and the light guide member (e.g., 19), would conclude that the claim language regarding the claimed features noted by the Examiner are at least reasonably clear, if not plainly apparent. It is accordingly submitted that claim 1 complies with 35 U.S.C. § 112, second paragraph and withdrawal of this rejection is requested.

Claim 1 is again being rejected under 35 U.S.C. § 102(e) as being anticipated by Matumoto (U.S. Patent No. 6,302,551) (hereinafter "**Matumoto**"). This rejection is respectfully traversed.

The Examiner alleges that **Matumoto** teaches a pointer (24) adapted to be turned around a rotary shaft (23), a display member (60) positioned on a rear side of the pointer (24) and adapted to be transmission illuminated, light sources (81, 82, 83) positioned on a rear side of the display member (60) and in the vicinity of the rotary shaft (23) and adapted to illuminate the display member (60), and a reflector (70, 71) positioned on the rear side of the display member (60) and provided with a reflecting portion. **Matumoto** is also said to identically teach a light guide member (60) positioned on the rear side of the display member and adapted to guide the light from the light sources (81, 82, 83) to the rear side of the display member, characterized in that a hollow portion is formed between a rear surface of the display member (20) and reflector (70, 71), an irradiation portion (183) adapted to apply the light (82, 83), which is reflected on the reflecting portion (70, 71) and illuminates the display member, to the interior of the hollow portion being provided on the light guide member (60, 61).

Under the law of anticipation, “[f]or a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim”. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). It is submitted that the Examiner has not demonstrated that **Matumoto** in fact discloses the “identical invention” claimed. Instead, the Examiner impermissibly resorted to a picking and choosing of elements from different embodiments of the disclosed invention to construct something falling within the text of the rejected claims.

For example, **Matumoto**’s reflection portion 183 (Fig. 10) is alleged to comprise the claimed “irradiation portion”, whereas **Matumoto**’s reflecting portions 70, 71 (Fig. 2) are alleged to comprise the claimed “reflecting portion”, even though **Matumoto** shows that they correspond to the same element in the two disclosed embodiments. Further, reference numeral (60) in **Matumoto** is relied upon as identically teaching the claimed “display member” and “light guide member”. The Examiner’s attempt to define a single object in two different embodiments of **Matumoto**’s disclosure as two separate claim elements itself mandates a *de facto* conclusion that there is no anticipation.

Still further, the Examiner also relies upon reference numeral (20) in **Matumoto** as disclosing the claimed “display member” even though the Examiner relies upon reference numeral (60) as disclosing the claimed “display member” in the very same rejection. “The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. “As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant...

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)(citations omitted). The Examiner’s rejection fails to set forth a coherent assertion of teaching in **Matumoto** amounting to a *prima facie* case of anticipation under 35 U.S.C. § 102(e).

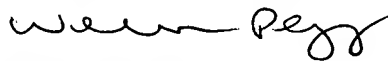
Lastly, the claimed “*irradiation portion of the light guide member*” adapted to apply the light, which is reflected on the reflecting portion and illuminates the display member, to the interior of the hollow portion being provided on the light guide member, is not taught by **Matumoto**. Instead, as alleged by the Examiner, **Matumoto** provides an irradiation portion (183) (Fig. 10) which is not a portion of the light guide member. Therefore, **Matumoto** fails to identically teach this element.

For all of the reasons noted above, it is submitted that the **Matumoto** fails to teach the identical subject matter claimed and fails to anticipate claim 1 under 35 U.S.C. 102(e).
Reconsideration and withdrawal of this rejection is requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



William D. Pegg
Registration No. 42,988

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 WDP:kap
Facsimile: (202) 756-8087
Date: June 17, 2004